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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,600	02/09/2001	Won-Il Son	EZI 111	5753

23995 7590 06/30/2004

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EXAMINER	
LASTRA, DANIEL	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/779,600	SON, WON-IL	
	Examiner	Art Unit	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 March 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-19 have been examined. Application 09/779,600 (METHOD AND APPARATUS FOR PROVIDING ADVERTISEMENTS0 has a filing date 02/09/2001 and foreign application 2000-06289 (02/10/2000).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 recites the limitation "said opinionnaire icon". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-13 are not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement

thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409

U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these

analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claim 1 recites a "useful, concrete and tangible result" (a method for providing advertisements), however the claims recite no structural limitations (i.e., computer implementation), and so they fail the first prong of the test (technological arts). Dependent claims 2-13 do not remedy this situation as no structural limitations are recited.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al (U.S. 6,138,155).

As per claim 1, Davis teaches:

A method for providing advertisements comprising the steps of:

receiving an advertisement from at least one source selected from a group consisting of sponsors and advertising agents (see column 3, lines 17-35; column 16, lines 53-67);

providing said advertisement to a user (see column 16, line 53 – column 17, line 14);

estimating an advertising commission according to the type of advertisement and manner of providing it to the said user (see column 16, lines 53-67; column 11, lines 32-37); and

demanding said advertising commission from at least one source selected from a group consisting of sponsors and advertising agents (see column 3, lines 17-35; column 16, lines 53-67);;

wherein an access commission is estimated and demanded from at least one source selected from a group consisting of sponsors and advertising agents when said user links to an advertisement-related site by means of said advertisement (see column 3, lines 17-35; column 16, lines 53-67).

As per claim 2, Davis teaches:

The method for providing an advertisement as claimed in claim 1, wherein the step of demanding said advertising commission from at least one source selected from a group consisting of sponsors and advertising agents comprises the steps of:

renewing a log file for recording the number of times said advertisement are provided to said user (see column 11, lines 32-40);

estimating the number of said advertisements that are provided to said user by analyzing the log file using streaming media and estimating said advertising commission by applying a predetermined commission rate to said estimated number of advertisements provided to a user (see column 16, line 54 – column 17, line 15).

As per claim 3, Davis teaches:

The method for providing an advertisement as claimed in claim 1 further comprising the steps of:

generating a log file for said user and converting said log file into a plurality of profiles according to the personal information of said user by using time data stored in said log file (see column 5, lines 1-6).

As per claim 4, Davis teaches:

The method for providing an advertisement as claimed in claim 3, wherein said personal information comprises at least one kind of information selected from the group consisting of gender, area, log history, occupation, hobby, school career, and customer level (see column 5, lines 1-7)

As per claim 5, Davis teaches:

The method for providing an advertisement as claimed in claim 1, wherein further comprising the steps of:

storing data about the time duration and contents of links with said advertisement-related site (see column 17, lines 1-15); and

estimating said access commission by applying a predetermined commission rate to said contents of a link (see column 16, line 53 – column 17, line 15).

As per claim 6, Davis teaches:

The method for providing an advertisement as claimed in claim 1 wherein the advertisement comprises at least one kind of information selected from a group consisting of normal image information, No Good (NG) image information, and advertisement-related information about Commercial Films (CF), movies, and music videos (see column 17, lines 1-14).

As per claim 7, Davis teaches:

The method for providing an advertisement as claimed in claim 1, wherein said advertisement is provided by at least one kind of icon selected from a group consisting of:

a CF parade icon for providing at least one kind of DF information selected from a group consisting of said normal image information and said NG image information (see column 14, lines 1-25);

a movie parade icon for providing at least one kind of movie information selected from a group consisting of said normal image information and said NG image information (see column 14, lines 1-25; column 17, lines 1-14); a music video parade

icon for providing at least one kind of music video information selected from a group consisting of said normal image information and said NG image information; a related information icon for providing said advertisement-related information, wherein said advertisement-related information is at least one kind of information selected from a group consisting of information about related persons, music and places related to said CF information, and said movie or music video information (see column 14, lines 1-25);

a learning space icon for providing expert information about said advertisement (see column 14, lines 1-25);

a shopping icon for providing a product advertised by said advertisement and a questionnaire icon for collecting opinions about said advertisement (see column 14, lines 1-25).

As per claim 8, Davis teaches:

The method for providing an advertisement as claimed in claim 7, further comprising the steps of:

receiving an information-demand signal according to which icon is selected by said user from among a group of icons consisting of said CF parade icon, said movie parade icon and said music video parade icon; and providing one kind of information selected from a group consisting of said CF information, said movie information and said music video information according to said information-demand signal received from said user (see column 14, lines 1-25).

As per claim 9, Davis teaches:

The method for providing an advertisement as claimed in claim 8 wherein the step of providing one selected from the group consisting of said CF information, said movie information and said music video information according to said information-demand signal for said user is accomplished by downloading (see column 17, lines 1-14).

As per claim 10, Davis teaches:

The method for providing an advertisement as claimed in claim 8 wherein said downloaded information is a moving image picture (see column 17, lines 1-15).

As per claim 11, Davis teaches:

The method for providing an advertisement as claimed in claim 7, wherein further comprising the steps of:

receiving an information-demand signal according to clicking on said related information icon from said user (see column 14, lines 1-25);

providing at least one advertisement-related information corresponding to said information-demand signal to the user, said advertisement-related information being one selected from the group consisting of a personal information, a music information, a place information and a gossip information about said CF information, said movie information and said music video information; and providing an access for a site related to the advertisement-related information to the user (see column 14, lines 1-25).

As per claim 12, Davis teaches:

The method for providing an advertisement as claimed in claim further comprising the steps of:

receiving an information-demand signal according to clicking on said learning space icon from said user; providing at least one advertisement-related information corresponding to said information-demand signal to the user, said advertisement-related information being one selected from the group consisting of an advertising knowledge, books related to said advertisement and an educational organ information related to said advertisement; and providing an access to a site related to the advertisement-related information to the user (see column 14, lines 1-25).

As per claim 13, Davis teaches:

The method for providing an advertisement as claimed in claim 7, but fails to teach wherein further comprising the steps of:

receiving an information-demand signal according to clicking said opinionnaire icon from said user; selecting a pertinent information in accordance with said information-demand signal, said pertinent information being one selected from the group consisting of researching, monitoring and rank deciding; and providing the pertinent information to said user (see column 2, lines 1-27).

As per claim 14, Davis teaches:

The method for providing an advertisement as claimed in claim 7, further comprising the steps of: receiving an information-demand signal according to clicking on said shopping icon; providing a pertinent information according to said information-demand signal for said user; and linking a related site corresponding to said pertinent information (see column 14, lines 1-25).

Claim 15 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 16, the apparatus for providing an advertisement as claimed in 15, contains the same limitations as claim 3 therefore the same rejection is applied.

As per claim 17, the apparatus for providing an advertisement as claimed in 16, contains the same limitations as claim 4 therefore the same rejection is applied.

As per claim 18, the apparatus for providing an advertisement as claimed in 15, contains the same limitations as claim 5 therefore the same rejection is applied.

As per claim 19, the apparatus for providing an advertisement as claimed in 15, contains the same limitations as claim 6 therefore the same rejection is applied.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
June 23, 2004

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